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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,647	01/29/2002	Michael Rosenthal	041165/9023	2467

7590 03/22/2004  
Timothy M Kelley  
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EXAMINER

MULCAHY, PETER D

ART UNIT PAPER NUMBER

1713

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/937,647	Applicant(s) ROSENTHAL ET AL.	
	Examiner Peter D. Mulcahy	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-23 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-23 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
       a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
           1. ☐ Certified copies of the priority documents have been received.  
           2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
           3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
       \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
       a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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Claims 14-23 and 27-29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants' recitation of the zinc compound is indefinite. Applicants identify this compound as being "selected from liquid and solid", saturated or unsaturated, straight chain or branched, mono or polyfunctional, aromatic or aliphatic. This language is seen to be not further limiting. This is to say that the zinc salt can only be liquid or solid and it must be either saturated or unsaturated and it is either going to be straight chain or branched and it will be either mono or polyfunctional and it can only be either aromatic or aliphatic. This language is simply not further limiting in that it is seen to encompass every conceivable compound. Applicants should clarify the record and clearly state exactly how this language which is seen to further limit the zinc compound or rewrite the claim so as to clearly set forth the ingredient.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

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the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-23 and 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ejk, U.S. Patent 4,132,691 taken alone or further in view of Sugahara et al., U.S. Patent 4,060,508.

The rejection as set forth under 35 U.S.C. § 103 with respect to the Ejk patent is herein repeated. The rejection has been modified slightly in that the Sugahara et al. patent is no longer being applied as a primary reference but rather as an alternative secondary reference.

The Examiner maintains that the rejection over Ejk alone is proper and applicants' arguments have been found to be not persuasive.

Applicants identify a portion of Ejk at column 4 line 8 where the disclosure identifies the oxides of zinc and lead as being not suitable since they can affect the heat stability of the vinyl chloride polymers. This is not seen to teach away from the utilization of a zinc stabilizer as alleged by applicants. The reference to the zinc and lead oxides as being not suitable are in contrast to the calcium and barium oxide and hydroxides which are preferred lubricants. Ejk recognized that the calcium and barium oxide and hydroxide compounds are the preferred

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lubricants. This does not detract from the teaching of the tin stabilizer and the incorporation of the carboxylic acid zinc salt at column 3 lines 35-43. Here it is clearly stated that one of ordinary skill in the art would recognize that the zinc salts are suitable heat stabilizers for vinyl chloride polymers.

Applicants acknowledge such to be the case and allege that there is no unambiguous teaching to use the carboxylic acid salt of zinc. The Examiner maintains that this disclosure is fairly clear as to the suitability of a carboxylic acid zinc salt and that there is no lack of clarity within this disclosure.

To further rebut applicants' statement that there is no clear unambiguous teaching to use the carboxylic acid zinc salt, the Examiner has applied the Sugahara patent as a secondary reference. Column 11 lines 3+ extensively discusses the advantages of using a zinc salt or zinc oxide type stabilizer. The Examiner maintains that it would be prima facie obvious to one of ordinary skill in the art to use the zinc salt as shown in Sugahara where the carboxylic acid salt is called for in Ej. As such, the claims are rendered prima facie obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (571) 272-1107. The examiner can normally be reached during regular business hours.

The fax telephone number for this group is (703) 872-9306.

Information regarding the status of an application may be


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obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P. Mulcahy:cdc  
March 18, 2004



**PETER D. MULCAHY**  
**PRIMARY EXAMINER**